



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,108	10/19/1999	HANS HSU	3783-4001	3647

23117 7590 09/15/2003

NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/421,108

Applicant(s)

HSU ET AL.

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 195-239 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 195-239 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3624

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/16/03 has been entered.

Response to Amendment

2. Amendments submitted on February 25, 2002 (paper no. 9) and March 6, 2002 (paper no. 10) have been entered per request and subsequently, the present amendment has been entered. New claims 212-239 have been added. Claims 195-239 are currently pending and have been examined.

3. Applicant's explanation regarding objection of the prior amendment filed Oct 26, 2001 as introducing new matter into the disclosure are persuasive. The new matter objection has been accordingly withdrawn. For the same reason prior rejection of claims 195-211 under 35 USC 112 (first) is also withdrawn.

4. Amendment of February 25, 2002 (paper no. 9) has overcome 112(second) rejection of claims 195-211.

Art Unit: 3624

Response to Arguments

5. Applicant's arguments with respect to rejection of claims 195, 196, 198, 201, 204-208 and 210-214 over prior art have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claims 218, 219, 226 and 227 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 195-219 and 228-233 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

Art Unit: 3624

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 195 is discussed as exemplary claim. The claim is rendered indefinite due to the following reasons.

8. Claim 195 recites a method for enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of any desired amount towards a gift. However, the claim does not recite providing price information to the gift givers before receiving monetary commitments from them. How are the givers to decide on making commitments for monetary contributions towards the purchase of a gift when viewing only the gift ideas without price associated with gift ideas. Furthermore, since, the price of gift ideas may vary considerably, the gift givers who wish to commit a monetary amount for a gift idea would not know what monetary amount to commit. Also, merely providing a display of the gift ideas that reflects the current monetary commitments without associated price of the gift idea (i.e. total commitment needed to purchase the gift) would not serve any usefulness because the givers would not know what monetary amount is still not committed (left to be contributed) and therefore what portion of the givers' commitment would be applied towards the selected gift. For this reason giver would not be able to make a monetary contribution

Art Unit: 3624

towards "any giver-desired portion of the uncommitted balance of the gift's purchase price". This deficiency renders independent claim indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As mentioned above, this analysis also applicable to other aforementioned claims.

Appropriate correction and/or explanation are required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 195, 196, 198, 201, 204-212, 216-220, 226-228 and 234 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and further in view of Smutko et al (Bridal Business can be the icing on your cake., Chilton's Hardware Age, v230, n11 p33(3), Nov, 1993) (Smutko).

Art Unit: 3624

Claim 195: Ucopia discloses a method for enabling a plurality of gift givers to each make a respective commitment for monetary contribution of any giver-desired amount toward a gift for a gift recipient, the method comprising:

Receiving at a centralized gift registry computer system gift ideas supplied by the gift recipient ("couples can choose items from an extensive list ...to build a personalized registry"... , para 5);

Storing the gift ideas in a memory which is part of , or accessible to, said gift registry computer system (this step is inherent in Ucopia, since the items chosen by the registered couples are to be presented to the potential gift givers via the gift registry);

Providing to the gift givers, based on the stored gift ideas and in response to requests supplied to said gift registry computer, an on-line of gift ideas (Ucopia: "guests enjoy the convenience of accessing all the selections in one place, and purchasing online... , para. 5);

Receiving at said gift registry computer system commitments from the gift givers for monetary contributions toward the purchase of a gift selected from the on-line display of gift ideas (Ucopia: higher-priced items may be designated for group purchases...refer to "Ucopia features" para 7, one of the

Art Unit: 3624

features is that a gift of high price, which may be beyond "their individual budget" are selected for collective or group purchases);

Combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the current commitments towards the selected gift (since the gift(s) selected for collective purchasing are designated as such, it is inherent that a potential contributor is informed of the commitment (monetary amount) already committed towards the gift or alternatively commitment amount still required towards the full amount of the item);

Automatically generating a purchase request for the selected gift if the total of the commitment is equal to or greater than the gift's purchase price(Ucopia instantly updates couple registries after purchases..., the automatically generating purchase request step is anticipated because the registered gift is designated for purchase via the registry);

Attempting to satisfy the purchase request (see discussion of above limitation "automatically generating purchase request...));

Ucopia, fails to disclose that the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's

Art Unit: 3624

purchase price. This is because, Utopia requires that the monetary contribution that a giver wish to commit be specified and communicated in terms of monetary equivalent shares (dollar amounts shares to be sold, Utopia). It should be noted that broadly interpreted Utopia in no way restricts the monetary value of a share of a gift item, only the number of shares a giver may purchase (as noted by the applicant) is restricted to "one or more". This means a recipient may attribute a value of a penny (or a smallest denomination of currency) which would enable the givers to commit "any" desired monetary amount towards the gift since amount may be expressed in any giver desired amount albeit still expressed as shares of the gift item.

Smutko, in the same field of endeavor, discloses a concept of gift registry which discloses a well known concept of "group buy" (p.3). Smutko teaches that in a group buy a plurality of givers (Gift buyers) each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price (this is inherent since Smutko, like in any group giving situation discloses a required process of recording commitment of each giver). Smutko, also, require that the price information communicated to and

Art Unit: 3624

commitments received from each giver be expressed in terms of monetary amounts (dollars and cents).

It would have been obvious to modify Utopia gift registry method in accordance with Smutko method of group buying where the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price. Because, doing so would allow the givers to contribute any desired monetary amount towards an expensive gift, thereby not restricting the monetary contribution to a multiple of share price designated. This would allow more gift givers to participate to commit monetary amounts towards purchase of expensive gifts. Another advantage of this modification of Utopia in accordance with Smutko would be that it would allow the recipient to specify the required amount of the gift in straight monetary units, i.e. Dollars and Cents (or nearest Dollars for convenience) unlike in Utopia which requires to the recipient to arbitrarily set a number of shares for a gift idea designated for group giving which restricts the givers to only a multiple of share units.

Claim 196: commitment of each giver commits to make a monetary contribution is directly specified by the giver as an amount of money (since each share represents an underlying predetermined fixed monetary amount, the giver may specify any

Art Unit: 3624

amount of money appropriate to monetary value of a gift by specifying number of shares that represent his/her desired contribution, in other words so long as the share price of Ucopia is an alternative representation of money).

Claim 198: sending the purchase request to a supplier (inherent feature of an on-line purchase such as Ucopia).

Claim 201: receiving credit card information supplied by the gift givers that make commitments (extremely conventional method of payment and therefore anticipated for gift purchase and/or commitment of gift amount).

Claims 204-206, 216-217, 224-225, 232-233 and 238-239:
features of receiving cash if the total of commitments is less than the gift's purchase price, one or more gift-ideas specified by the gift recipient is associated with a recipient is associated with a recipient determined price (or vendor) (well established business practices and therefore inherent to this reference).

Note that Claims 207 and 208 have been analyzed as per corresponding method claim 195. Since Ucopia method is implemented over the Internet both Computer-readable medium that store instructions and a programmed computer that is programmed to perform the method step are inherent to Ucopia.

Art Unit: 3624

All limitations of system claims 209 have been analyzed as in corresponding method claim 195.

Claim 210: communication network is the Internet (para 1,...the Internet's leading gift registry..).

Claim 211: limitation of the gift giver directly specifying the contribution as an amount of money is discussed in claim 195 as a combination of Utopia and Kmutko.

Claim 212 is analyzed similarly as per claim 195 with the following further explanation of the applied references:

Smutko teaches that the gift price (total gift amount) is specified in dollar amount and the members of the group buy commits (pays) a part of the total gift amount of the gift (amount paid by a giver towards the purchase of the gift). Also note that the aforementioned commitment of each giver for part of the total gift amount is directly specified by the gift giver as an amount of currency (the amount reflects amount of currency paid by a buyer).

For motivation of combining the Utopia and Smutko please refer to analysis of claim 195.

Claims 216-217 are analyzed per claims 204 and 205 respectively.

Art Unit: 3624

Claims 218 and 219 have been analyzed as per corresponding method claim 212. Note that since Utopia method of gift giving is computerized (internet based) both storage medium (claim 218) and a computer system are inherent therein.

Claim 220: This claim requires that each gift idea received and stored has corresponding "specified total gift amount". The gift ideas and the gift amounts are then displayed to gift givers who commit a part of the total gift amount for a selected gift idea. Commitments from gift givers for the gift ideas are combined and purchase request is (automatically) generated if the total amount of the commitments for a gift idea is reached or exceeds the specified total gift amount for that gift idea.

The analysis of claim 195 already reflected "specified total gift amount" as "price" of the gift. All other steps were predicated on the gift giver knowing the price (any giver desired monetary amount) as discussed as in combination of Utopia and Smutko.

Claims 226 and 227 have been analyzed as per corresponding method claim 220. Note that since Utopia method of gift giving is computerized (internet based), therefore, both storage medium (claim 218) and a computer system are inherent therein.

Claims 228 and 234 are analyzed as per corresponding method claims 212 and 220 respectively.

Art Unit: 3624

11. Claim 197, 213, 221, 229 and 235 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ucopia and Smutko as applied to claim 195 and further in view of weddingchannel.com.

(Exemplary analysis of claim 197 applies to other aforementioned claims)

Claim 197: generating one or more web pages based on gift ideas supplied by the gift recipient; and supplying the generated web pages to the gift givers in response to giver-supplied requests (refer to link "view item" next to the item listed, the giver is supplied with the web pages pertaining to the gift of interest);

Ucopia as applied to claim 195 fail to clearly recite the features of aforementioned claims. However, as discussed above, weddingchannel.com discloses generating web pages, supplying web pages to gift givers. It would have obvious to one of ordinary skill in the art at time of the claimed invention to implement these steps in Ucopia/Smutko combination as analyzed per claim 195.

Motivation for adding this feature is to provide the giver all necessary information and graphic display about the gift item so as to help him or her view the gift item and make decision towards gift purchase.

12. Claims 199 and 200 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and Smutko as applied to claim 195 and further in view of Ojha et al (US Pat. 6,598,026) (Ojha)

Art Unit: 3624

Claim 199: Utopia as applied to claim 195 fail to teach features of sending an offer to purchase the selected gift to a plurality of vendors and subsequently receiving an acceptance of the offer from one of the vendors and requesting the accepting vendor to send the selected gift to the recipient. However, Ojha, in the same field of endeavor discloses a method for brokering transactions. Ojha teaches sending offers to purchase the selected (gift) item (a plurality of products, abstract) to a plurality of vendors (sellers), an acceptance of the offer from one of the vendors and accepting offer as per claim 199. It would have been obvious to one of ordinary skill in the art at the time of invention to implement in Utopia/Smutko combination as analyzed per claim 195, the feature of sending purchase offers to a plurality of vendors and receiving an acceptance of offer from one of the offers from a vendor as per Ojha because this would provide the most competitive price of the selected gift item for the buyer.

All other limitations of claim 199 are analyzed as per claim 195.

Regarding claim 200, the cited references of Utopia and Smutko as discussed in analysis of claim 195 fail to teach adding the purchase request and aggregating purchase request

Art Unit: 3624

while they teach sending the offer to a plurality of vendors to fulfill the offer of the gift item. Ojha, in the same field of endeavor, discloses sending request for a purchase of a plurality of products and subsequent consummation of the purchase request (bid) (see abstract and Background of the Invention).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the steps of adding purchase request and aggregating purchase request and sending purchase offers to a plurality of vendors and receiving an acceptance of offer from one of the offers from a vendor because this would provide the most competitive price of the selected gift item for the buyer. Aggregating purchase request for identical products would allow the purchaser to receive more favorable price due to volume discount.

All other limitations of claim 200 are analyzed as per claims 195 and 199.

13. Claims 202, 214, 222, 230 and 236 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and Smutko as applied to claim 195 and further in view of Kopetman (Starr Rides to Freedom Bowl rescue Last-Day Scramble Secures Necessary

Art Unit: 3624

Loans, Donations, The Los Angeles Times June 28, 1986 pg. 5
(Kopetman).

[Note: The following analysis of claim 202 applies to all
other aforementioned claims]

UCOPIA as applied to claim 195 (claim 212 for claim 214)
fail to teach however in the same field of endeavor, Kopetman
teaches receiving commitments from the gift givers that include
commitments which are contingent upon other gift givers making
commitments such that the total of all commitments is equal to
or greater than the price of the selected gift (refer to
abstract, and full text, \$527,000 corresponds to total price of
the gift, \$125,000 is contingent amount..).

It would have been obvious to one of ordinary skill in the
art at the time of the invention to implement the feature of a
giver making a commitment which is contingent as per Kopetman in
the above referenced combination of UCOPIA and Smutko because
the gift giver would be assured of the purchase of the selected
gift. Furthermore, such contingent commitment would also entice
other givers to commit their contribution towards the selected
gift.

14. Claims 203, 215, 223, 231 and 237: are rejected under 35
U.S.C. 103(a) as being unpatentable over UCOPIA and Smutko as
applied to claim 195 and further in view of Linstedt (Shoppers

Art Unit: 3624

Sweep into Area Stores), Buffalo News, November 29, 1997.

(Linstedt).

Claims 203 (exemplary): UCOPIA fail to disclose, however, in the same field of endeavor, Linstedt discloses, that when shopping for gifts the receivers desire a substitute gift item in lieu of a specific gift item. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the recipient specify a substitute option added to Ucopia/Smutko combination as analyzed per claim 195 because it would ensure that a gift item similar to the one substituted for is available for the givers to select from.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Art Unit: 3624

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

9/8/03